REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 28, 2004. At the time of the Office Action, Claims 1-7 and 9-13 were pending in the Application and stand rejected. Applicant has amended Claim 9. Applicant respectfully requests reconsideration and favorable action in this case in view of the following remarks.

Section 112, Para. 1 Rejections

The Examiner rejects Claim 9 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant respectfully traverses this rejection. However, in order to advance prosecution of this case, Applicant has amended Claim 9 and submits that the specification, most notably at pages 46 and 47 of the specification, conveys with reasonable clarity to one skilled in the art that, at the time the application was filed, Applicant had possession of the claimed invention. Reconsideration and favorable action are respectfully requested.

Section 101 Rejections

The Examiner rejects Claim 9 under 35 U.S.C. § 101 because the disclosed invention lacks utility. The Examiner also rejects Claim 9 under 35 U.S.C. § 101 because the disclosed invention is inoperative and therefore lacks utility. Applicant traverses these rejections, and encourages the Examiner to review the utility of invention standard set forth in M.P.E.P. § 2107.

Applicant submits the utility of the invention in Claim 9 is, at the very least, to facilitate configuration of a product from a set of components which can be selectively combined in different ways to form a plurality of different component combinations that each serves as a separate product by changing the definition of the combination of components. Even assuming for the purposes of argument that the Examiner's assertions about the present invention are accurate, the invention does not have to be advantageous to use to have utility, as the Examiner appears to believe. Nor does the invention need to be cost-effective. Because these are not proper grounds for a utility rejection, Applicants respectfully request reconsideration and favorable action.

Section 103(a) Rejections

The Examiner rejects Claims 1-3, 5, 6, and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2002/0035463 A1 to Lynch, et al. (*"Lynch"*) in view of Deang, et al. (IEEE, 1998) (*"Deang"*). The Examiner further rejects Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch* in view of *Deang*, and further in view of Mori, et al. (IEEE, 1993) (*"Mori"*). The Examiner also rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch* in view of *Deang*, and further in view of U.S. Patent 6,647,428 to Bannai, et al. (*"Bannai"*). Applicant respectfully traverses these rejection for the reasons discussed below.

Applicant submits that the Examiner has not shown a *prima facie* case of obviousness for at least two reasons. First, the required suggestion or motivation to combine *Lynch* and *Deang* has not been shown. Second, assuming for the sake of argument that a suggestion or motivation to combine *Lynch* and *Deang* is shown, *Lynch* and *Deang*, whether alone or in combination, still fail to disclose all of the limitations of the pending claims.

No Motivation to Combine

With respect to independent Claim 1, the Examiner states first at page 8 of the Office Action that, *"Deang* teaches identifying a criteria set having a plurality of different states which each correspond to a respective one of the products [cite], as that allows a system synthesis process by creating a system or subsystem from basic components according to a set of performance, cost and functionality requirements [cite]," and then states, "it would have been obvious to one of ordinary skill in the art . . . to combine the method of LY with the method of DE that includes identifying a criteria set having a plurality of different states which each correspond to a respective one of the products, as that allows a system synthesis process by creating a system or subsystem from basic components according to a set of performance, cost and functionality requirements." Thus, the Examiner's apparent reason for combining *Lynch* and *Deang* is merely a statement taken from Page 1, Col. 1, Para. 2 of *Deang*, which is just a basic statement regarding system level synthesis. This statement proffers no evidence whatsoever of a motivation to combine *Lynch* and *Deang* and, hence, the Examiner has not established a *prima facie* case of obviousness.

The fact that a prior art system could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon,* 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The Examiner is reminded that "[t]he factual inquiry whether to combine references must be thorough and searching." *In re Sang-Su Lee,* 277 F.3d 1338, 1343. And "[an] examiners conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Based on this lack of evidence, it is obvious that the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of *Lynch* and *Deang.*

In addition, Applicant submits that one skilled in the art would not be motivated to combine *Lynch* and *Deang* because *Lynch* is directed towards a "constraint-based" configuration system (*see, e.g., Lynch,* col. 3, para. 0027), while *Deang* is directed towards a "rules-based" synthesis system (*see, e.g., Deang,* page 2, col. 1, para. 2). In fact, *Lynch* teaches away from a rules-based configuration system in its BACKGROUND section. Furthermore, attempting to combine these two different systems would change the principle of operation of the system in *Lynch,* which is not allowed. *See* MPEP, § 2143.01.

Consequently, for at these reasons, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-7 and 9-13, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine *Lynch* and *Deang.* Applicant respectfully requests reconsideration and allowance of Claims 1-7 and 9-13.

Each and Every Limitation Not Taught or Suggested

Claim 1, in part, discloses "determining whether each said component in said set corresponds to a second component class involving components that are required in each said product but that vary among said products with respect to at least one of quantity and type." The Examiner states that *Lynch* discloses this limitation. Office Action, at pp. 7-8. However, *Lynch* merely discloses "five intrinsic base classes 70 that define the basic types of model objects. [A] component [class] 60 is the base class from which all other classes and component types are derived. Derived classes 88 are definitions of broad component categories, such a storage devices, power supplies, and peripheral cards." *Lynch,* page 5, para. 0065. Thus, *Lynch* fails to disclose "a second component class involving components that are required in each said product but that vary among said products with respect to at

least one of quantity and type," as recited in Claim 1. *Deang* also does not teach or suggest this limitation.

In addition, Claim 1 recites, in part, "determining whether each said component in said set corresponds to a third component class involving components that are present in some but not all of said products, the components corresponding to said second and third component classes collectively forming a component group." The Examiner states that *Lynch* discloses this limitation. Office Action, at page 8. However, for reasons analogous to those in the paragraph above, *Lynch* fails to disclose *second and third component classes*, let alone determining whether each said component in said set corresponds to a third component class *involving components that are present in some but not all of said products*, or that the components corresponding to said second and third component classes collectively forming a component group, as recited in Claim 1. *Deang* also does not teach or suggest this limitation.

For at least these additional reasons, a *prima facie* case of obviousness cannot be maintained with respect to Claim 1, because the cited references fail to disclose each and every limitation of Claim 1. Therefore, Applicant respectfully requests reconsideration and allowance of Claim 1, as well as Claims 2-7 and 9-13, which depend from Claim 1.

In addition to depending from independent Claim 1, which is shown above to be allowable, Claim 2 is also allowable because it contains additional limitations not disclosed by *Lynch* and *Deang*. For example, Claim 2 recites, in part, "said products each have therein one of a plurality of different combinations of the components corresponding to said second component class." The Examiner states that *Lynch* discloses this limitation. Office Action, at page 9. However, for reasons analogous to those in the paragraphs above, *Lynch* fails to disclose a *second component class*, let alone that said products each have therein *one of a plurality of different combinations of the components* corresponding to said second component class, as recited in Claim 2. *Deang* also does not teach or suggest this limitation.

For at least this additional reason, a *prima facie* case of obviousness cannot be maintained with respect to Claim 2, because the cited references fail to disclose each and every limitation of Claim 2. Therefore, Applicant respectfully requests reconsideration and allowance of Claim 2.

In addition to depending from independent Claim 1, which is shown above to be allowable, Claim 10 is also allowable because it contains additional limitations not disclosed by *Lynch* and *Deang*. For example, Claim 10 recites that the method also includes, prior to the determining steps, the step of "generating for each said component respective component information which includes an identification of all types of the component and includes configuration information defining the conditions under which a particular type and quantity of that component are used in each of said products." The Examiner states that *Lynch* discloses this limitation. Office Action, at page 13. However, since *Lynch* discloses a constraint-based system, then this "rules-based" limitation cannot be taught or suggested by *Lynch*. Hence, *Lynch* fails to disclose generating configuration information that includes an identification of *all types of the component* and configuration information defining the *conditions under which a particular type and quantity of that component are used* in each of said products, as recited in Claim 10. *Deang* also does not teach or suggest this limitation.

For at least this additional reason, a *prima facie* case of obviousness cannot be maintained with respect to Claim 10, because the cited references fail to disclose each and every limitation of Claim 10. Therefore, Applicant respectfully requests reconsideration and allowance of Claim 10.
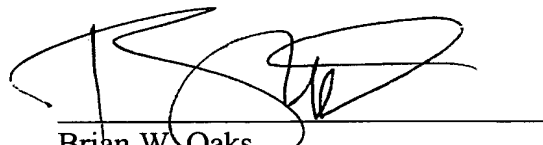
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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